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ASUSTEK COMPUTER INC. AND
9 ASUS COMPUTER INTERNATIONAL

10
11 UNITED STATES DISTRICT COURT
12 NORTHERN DISTRICT OF CALIFORNIA
13 SAN FRANCISCO DIVISION
14

15 ASUSTEK COMPUTER INC. and ASUS
16 COMPUTER INTERNATIONAL,

17 Plaintiffs,

18 v.

19 RICOH COMPANY, LTD.,

20 Defendant.

21 AND RELATED COUNTERCLAIMS.
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23
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CASE NO. C 07-01942-MHP

**ASUSTEK COMPUTER INC. AND ASUS
COMPUTER INTERNATIONAL'S
RESPONSE TO RICOH COMPANY,
LTD.'S COUNTERCLAIMS**

JURY TRIAL DEMANDED

1 Plaintiffs and Counterclaim Defendants ASUSTeK Computer Inc. and ASUS Computer
 2 International (collectively, "Asustek") respond as follows to the Counterclaims and allegations
 3 asserted in paragraphs 60 through 84 of Defendant Ricoh Company Ltd.'s Answer to Complaint
 4 and Counterclaims:

5 **GENERAL ALLEGATIONS**

- 6 1. Asustek admits the allegations of paragraph 60.
- 7 2. Asustek admits the allegations of paragraph 61.
- 8 3. On information and belief, Asustek admits the allegations of paragraph 62.
- 9 4. Asustek admits that Ricoh's Counterclaim in paragraph 63 purports to set forth
 10 claims arising under the Patent Laws of the United States.
- 11 5. Asustek admits the allegations of paragraph 64.

12 **COUNT I – Infringement of the '552 Patent**

- 13 1. With respect to paragraph 65, Asustek incorporates by reference its responses to
 14 the allegations set forth in the previous paragraphs.
- 15 2. With respect to paragraph 66, Asustek admits that, on its face, United States Patent
 16 No. 5,063,552 appears to have issued on November 5, 1991 and to have been assigned to Ricoh
 17 Company Ltd. Asustek is without knowledge or information sufficient to form a belief as to the
 18 remaining allegations of paragraph 66, and on that basis denies the remaining allegations.
- 19 3. Asustek denies each and every allegation of paragraph 67, including
 20 subparts (a)-(e).
- 21 4. Asustek denies each and every allegation of paragraph 68.
- 22 5. Asustek admits that Ricoh has demanded that Asustek Computer Inc. pay Ricoh a
 23 royalty. Except as so expressly admitted, Asustek denies each and every allegation of
 24 paragraph 69.

25 **COUNT II – Infringement of the '955 Patent**

- 26 1. With respect to paragraph 70, Asustek incorporates by reference its responses to
 27 the allegations set forth in the previous paragraphs.

2. With respect to paragraph 71, Asustek admits that, on its face, United States Patent No. 6,172,955 appears to have issued on January 9, 2001 and to have been assigned to Ricoh Company Ltd. Asustek is without knowledge or information sufficient to form a belief as to the remaining allegations of paragraph 71, and on that basis denies the remaining allegations.

3. Asustek denies each and every allegation of paragraph 72, including subparts (a)-(e).

4. Asustek denies each and every allegation of paragraph 73.

5. Asustek admits that Ricoh has demanded that Asustek Computer Inc. pay Ricoh a royalty. Except as so expressly admitted, Asustek denies each and every allegation of paragraph 74.

COUNT III – Infringement of the ‘109 Patent

1. With respect to paragraph 75, Asustek incorporates by reference its responses to the allegations set forth in the previous paragraphs.

2. With respect to paragraph 76, Asustek admits that, on its face, United States Patent No. 6,631,109 appears to have issued on October 7, 2003 and to have been assigned to Ricoh Company Ltd. Asustek is without knowledge or information sufficient to form a belief as to the remaining allegations of paragraph 76, and on that basis denies the remaining allegations.

3. Asustek denies each and every allegation of paragraph 77, including subparts (a)-(e).

4. Asustek denies each and every allegation of paragraph 78.

5. Asustek admits that Ricoh has demanded that Asustek Computer Inc. pay Ricoh a royalty. Except as so expressly admitted, Asustek denies each and every allegation of paragraph 79.

COUNT IV – Infringement of the ‘755 Patent

1. With respect to paragraph 80, Asustek incorporates by reference its responses to the allegations set forth in the previous paragraphs.

2. With respect to paragraph 81, Asustek admits that, on its face, United States Patent No. 6,661,755 appears to have issued on December 9, 2003 and to have been assigned to Ricoh

1 Company Ltd. Asustek is without knowledge or information sufficient to form a belief as to the
2 remaining allegations of paragraph 81, and on that basis denies the remaining allegations.

3 3. Asustek denies each and every allegation of paragraph 82, including
4 subparts (a)-(e).

5 4. Asustek denies each and every allegation of paragraph 83.

6 5. Asustek admits that Ricoh has demanded that Asustek Computer Inc. pay Ricoh a
7 royalty. Except as so expressly admitted, Asustek denies each and every allegation of
8 paragraph 84.

9 **RESPONSE TO RICOH'S PRAYER FOR RELIEF**

10 1. Asustek denies that Ricoh is entitled to any of the relief requested in Ricoh's
11 Prayer for Relief, including Paragraphs A through G.

12 **AFFIRMATIVE DEFENSES**

13 1. Asustek asserts, as its further and separate defenses to Ricoh's Counterclaims, the
14 following affirmative defenses.

15 **FIRST AFFIRMATIVE DEFENSE**

16 **Failure To State a Claim**

17 2. Ricoh's Counterclaims fail to state a claim upon which relief can be granted.

18 **SECOND AFFIRMATIVE DEFENSE**

19 **Invalidity**

20 3. Each claim of the '552 Patent is invalid for failure to meet the statutory and
21 decisional requirements and/or conditions for patentability under 35 U.S.C. §§ 101, 102, 103
22 and/or 112.

23 4. Each claim of the '955 Patent is invalid for failure to meet the statutory and
24 decisional requirements and/or conditions for patentability under 35 U.S.C. §§ 101, 102, 103
25 and/or 112.

26 5. Each claim of the '109 Patent is invalid for failure to meet the statutory and
27 decisional requirements and/or conditions for patentability under 35 U.S.C. §§ 101, 102, 103
28 and/or 112.

1 6. Each claim of the '755 Patent is invalid for failure to meet the statutory and
2 decisional requirements and/or conditions for patentability under 35 U.S.C. §§ 101, 102, 103
3 and/or 112.

4 **THIRD AFFIRMATIVE DEFENSE**

5 **Collateral Estoppel**

6 7. Ricoh is barred under the doctrine of collateral estoppel from asserting the patents-
7 in-suit due to the prior rulings and judgment of the United States District Court for the Western
8 District of Wisconsin.

9 **FOURTH AFFIRMATIVE DEFENSE**

10 **Equitable Estoppel**

11 8. Ricoh is estopped from obtaining any relief sought in its Counterclaims because of
12 the doctrine of equitable estoppel.

13 **FIFTH AFFIRMATIVE DEFENSE**

14 **License**

15 9. On information and belief, the components used by Asustek in the products
16 accused by Ricoh in its Counterclaims are manufactured and/or sold to Asustek subject to a
17 license or non-assertion agreement between Ricoh and Pioneer Corporation.

18 **SIXTH AFFIRMATIVE DEFENSE**

19 **Patent Exhaustion**

20 10. On information and belief, the components used by Asustek in the products
21 accused by Ricoh in its Counterclaims are manufactured and/or sold to Asustek subject to a
22 license or non-assertion agreement between the component manufacturer or supplier and Ricoh,
23 thereby exhausting Ricoh's patent rights, if any, over the accused products.

24 **SEVENTH AFFIRMATIVE DEFENSE**

25 **Prosecution History Estoppel**

26 11. On information and belief, as a separate affirmative defense, Ricoh's
27 Counterclaims are barred under the doctrine of prosecution history estoppel, and Ricoh is
28

1 estopped from claiming that the '552 Patent, the '955 Patent, the '109 Patent and/or the '755
2 Patent cover or include any of Asustek's products or services.

3 **EIGHTH AFFIRMATIVE DEFENSE**

4 **Damages**

5 12. Ricoh's alleged damages are barred and/or limited by the provisions of 35 U.S.C.
6 §§ 286 and/or 287.

7 **NINTH AFFIRMATIVE DEFENSE**

8 **Reservation of Defenses**

9 13. Asustek reserves all affirmative defenses under Rule 8(c) of the Federal Rules of
10 Civil Procedure, the Patent Laws of the United States, and any other defenses, at law or in equity,
11 that may now or in the future be available based on discovery or any other factual investigation
12 concerning this case.

13 **SUPPLEMENTAL PRAYER FOR RELIEF**

14 WHEREFORE, Asustek further prays that this Court:

15 A. Award to Asustek the relief sought in its Complaint;

16 B. Adjudge and decree that Ricoh's counterclaims are dismissed with prejudice, that
17 judgment be entered in Asustek's favor and against Ricoh, and that Ricoh be denied all relief
18 requested in its counterclaims;

19 C. Adjudge and decree that Ricoh is not entitled to any damages from Asustek or any
20 injunctive relief under its counterclaims;

21 D. Award Asustek its fees and costs in defending against Ricoh's counterclaims,
22 including its reasonable attorneys' fees and interest; and

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1 E. Award Asustek such further necessary and proper relief as this Court may deem
2 just and reasonable.

3 DATED: October 12, 2007

Respectfully submitted,

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5 MICHAEL N. EDELMAN
6 VID BHAKAR
7 SHANÉE Y. WILLIAMS
8 PAUL, HASTINGS, JANOFISKY & WALKER LLP

9 By: /s/ Shanée Y. Williams
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12 ASUS COMPUTER INTERNATIONAL

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